Hovsepian v. Apple, Inc.

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EXHIBIT 12

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PATENT
Attorney Docket No. 2473.0001-02

MAIL ROOM SEP 21 1994 47 PAT. & TRADEMARK OFF.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Paul YURT et al.	
Serial No.: 08/133,982	Group Art Unit: 2603
Filed: October 8, 1993	Examiner: A. Le
For: AUDIO AND VIDEO TRANSMISSION AND RECEIVING SYSTEM	

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

AMENDMENT

This is a response to the Office Action mailed on August 9, 1994, the period for response to which extends through November 9, 1994.

Please amend the application as follows:

IN THE SPECIFICATION:

Page 12, line 8, after "recorder." insert --The receiving system recognizes copy protected programs and disables the audio/video recorder.--

C1

IN THE CLAIMS:

Claim 39, line 2, delete "central".

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REMARKS

In the Office Action, the Examiner rejected claims 21, 22, and 40 under 35 U.S.C. § 101 in view of U.S. Patent No. 5,132,992 ("the '992 patent") and rejected claims 23 through 39 and 42 through 49 under the judicially created doctrine of obviousness-type double patenting in view of the '992 patent. The Examiner also objected to the specification and rejected claim 39 under 35 U.S.C. § 112, second paragraph.

In response to the Examiner's objection to the specification, Applicants have amended the specification. Applicants respectfully submit that the amendment fully responds to the Examiner's objections.

In response to the Examiner's rejection of claim 39 under 35 U.S.C. § 112, second paragraph, Applicants have amended claim 39. Applicants respectfully submit that the amendment to claim 39 fully responds to the Examiner's rejection and places claim 39 in conformance with 35 U.S.C. § 112, second paragraph.

In response to the Examiner's rejection for obviousness-type double patenting in view of the '992 patent, Applicants are filing a Terminal Disclaimer with this amendment. Applicants respectfully submit that the Terminal Disclaimer fully responds to the Examiner's rejection. While Applicants do not subscribe to the Examiner's observation regarding obviousness, the Terminal Disclaimer is being filed in order to advance the prosecution of this application as quickly as possible.

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The Examiner's rejection of claims 21-22 under 35 U.S.C. § 101 is improper. A rejection under 35 U.S.C. § 101 for double patenting only applies to a claimed invention drawn to identical subject matter in an issued patent. In re Longi, 759 F.2d 887, 892 (Fed. Cir. 1985).

Claims 21 and 22 of the application cover different subject matter than claim 1 of the '992 patent. For example, as the Examiner recognizes, claims 21 and 22 do not recite ordering means and compression means as claim 1 does. Thus, a system may infringe claims 21 and 22 without infringing claim 1 of the '992 patent, and the claims must be drawn to different inventions. Additionally, claim 21 recites coordinated transmission of the formatted data which is not recited in claim 1 of the '992 patent, and claim 22 recites a plurality of geographically separated libraries which are not recited in claim 1 of the '992 patent. Therefore, claims 21 and 22 do not recite the same invention as claim 1 of the '992 patent, and Applicants request withdrawal of the 35 U.S.C. § 101 rejection.

The Examiner's rejection of claim 40 under 35 U.S.C. § 101 is also improper. Claim 40 covers different subject matter than claim 25 of the '992 patent. For example, as the Examiner recognizes, method claim 40 of the present application does not recite data decompressing, while apparatus claim 25 of the '992 patent recites data decompressing means. Claim 25 of the '992 patent does not recite transmitting a representation of at least one item at a real time rate to at least one of a plurality of subscriber receiving stations, as claim 40 does.

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Additionally, an identical invention double patenting rejection should not apply between a method claim, which is not limited to a specific apparatus, and an apparatus claim, which is not limited to practicing a specific method.

Therefore, claim 40 of the present application is drawn to a different invention than claim 25 of the '992 patent, and Applicants request the Examiner remove the rejection under 35 U.S.C. § 101.

Claims 21-49 are therefore in condition for allowance, and Applicants request reconsideration of the application, and allowance of the pending claims.

If there are any fees due in connection with the filing of this amendment, please charge the fees to our Deposit Account No. 06-0916. If an extension of time under 37 C.F.R. 1.136 not accounted for above is required for the entry of this amendment, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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GARRETT & DUNNER

By: [signature]
Michael R. Kelly
Registration No. 33,921

Dated: September 21, 1994

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